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MAR 30 2005

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In re Application of :
Shuichi Hirayama :
Application No. 10/076,956 : DECISION ON PETITION
Filed: February 19, 2002 :
Attorney Docket No. SN-US025009 :

This is a decision on the petition filed on January 19, 2005 by which petitioner requests that a new Office action be promulgated to replace the final rejection dated September 24, 2004 that is alleged to be defective. Petitioner also requests entry of a previously filed amendment that was refused entry after the final rejection. The petition is being considered under 37 CFR 1.181, and no fee is required for the petition.


The petition is granted.

It appears from the record that the final rejection dated September 24, 2004 included an Office Action Summary Form PTOL-326 that indicates on its face that claim 28 was finally rejected. It further appears from the record that the text of the Office action does not specifically include a rejection of claim 28. A review of the final rejection shows that it would appear that the limitation added to parent claim 1 by dependent claim 28 is identical to a limitation appearing in independent claim 8. Claim 1 was rejected under 35 USC § 103 for obviousness, based upon the teachings of two prior art patents. Claim 8, an independent claim, was rejected for obviousness based upon the same two prior art patents, with the addition of a third prior art patent. The discussion of the third prior art patent supplied by the examiner is directed to the same limitation that appears in claim 28.

Petitioner alleges that the final rejection in question is incomplete. Petitioner is correct. That the examiner's action can be construed one way, does not mean that petitioner is required to construe it that way to the exclusion of the possibility that the failure to reject claim 28 was precisely what the examiner intended. Further, there is no excuse for the basis of the rejection to have been expressly set forth in an advisory action only after a previous advisory action refusing entry of claim 28 re-written in independent form had been promulgated. While it can be argued that petitioner should not have "guessed" what the examiner meant (see petition, page 2), it is certainly true that petitioner was not required to construe the examiner's action against petitioner's own interests.

Accordingly, the finality of the Office action dated September 24, 2004 is hereby vacated. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3728 who will have the finality vacated, the amendment filed on December 12, 2004 entered as a matter of right, and will then forward the application to the examiner for immediate action not inconsistent with this Decision.

PETITION GRANTED.



E. R. Kazenske, Director
Technology Center 3700